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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,595	12/30/1998	JEFFREY C. BELT	13237-2305-M	1356
27488	7590	05/05/2004	EXAMINER	
MERCHANT & GOULD P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			ANYA, CHARLES E	
			ART UNIT	PAPER NUMBER
			2126	16
DATE MAILED: 05/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/223,595

Applicant(s)

BELT ET AL.

Examiner

Charles E Anya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-6 and 8-28 are pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-6 and 8-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,995,756 to Herrmann in view of U.S. Pat. No. 6,594,682 to Peterson et al.**

4. As to claim 1, Herrmann teaches a method comprising the steps of: for each file in the set of files identifying a handler routine and sending each file to the identified handler routine (MIME Types Col. 3, Ln. 31 – 67, Col. 8, Ln. 11 – 67, Col. 9, Ln. 33 – 67, Col. 9 Ln. 43 – 45) and for each file in the set of files, in the identified handler routine, determining the application functionality required to execute each file (Col. 9, Ln. 43 – 55).

5. Herrmann is silent with respect to a method for identifying application functionality needed to run a set of files when a computer is disconnected from a network.

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6. Peterson teaches a method for identifying application functionality needed to run a set of files when a computer is disconnected from a network (Offline Submission Col. 12 Ln. 32 – 43).

7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Peterson and Herrmann because the teaching of Peterson would improve the system of Herrmann by allowing a user to work offline from the server in a manner that feels familiar to working online (Peterson Col. 12 Ln. 41 – 43).

8. As to claim 2, Herrmann teaches the application functionality to comprise of products, features and components (Microsoft Word Col. 8, Ln. 11 – 18).

9. As to claim 3; Herrmann teaches identifying the set of files and storing the set of on the computer (Col. 9, Ln. 56 – 67).

10. As to claim 4, Herrmann teaches the method comprising the steps of: determining the set of files to be stored locally on the computer, identifying a type for each file in the set of files storing the set of files locally on the computer for each file (Col. 8, Ln. 43 – 54), associating the type with a handler routine, sending each file to the associated handler routine to identify application functionality needed to run each file (MIME Types Col. 3, Ln. 31 – 67, Col. 8, Ln. 11 – 67, Col. 9, Ln. 33 – 67, Col. 9 Ln. 43 –

45) and installing the identified application functionality locally on the computer (Col. 9, Ln. 56 – 65).

11. Herrmann is silent with respect to a method for identifying a set of files and application functionality needed to run the set of files when the computer is disconnected from a network.

12. Peterson teaches a method for identifying a set of files and application functionality needed to run the set of files when the computer is disconnected from a network Offline Submission Col. 12 Ln. 32 – 43).

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Peterson and Herrmann because the teaching of Peterson would improve the system of Herrmann by allowing a user to work offline from the server in a manner that feels familiar to working online (Peterson Col. 12 Ln. 41 – 43).

14. As to claim 5, Herrmann teaches the method of Claim 4, wherein the step of determining the set of files to be stored locally on the computer comprises receiving user input, wherein the user input corresponds to a plurality of files that are to be stored locally on the computer (Col. 11 Ln. 10 – 17).

15. As to claim 6, Herrmann does not explicitly teach the method of Claim 4, wherein the step of determining the set of files to be stored locally on the computer comprises the steps of: searching a plurality of files in a plurality of storage locations on the

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computer, determining whether each file found in the plurality of storage locations is to be stored locally on the computer; and if so, then adding the file to the set of files.

However, Herrmann teaches multiple application pages/files can be located using hyperlinks (Col. 9, Ln. 32 – 42). These hyperlinks includes several storage locations.

Secondly a determination is first made as to whether the files are located locally then looking at a remote location as result looking for the files in a plurality of locations (local and remote) (Col. 12, Ln. 42 – 54) and determining whether each file is to be stored locally and adding the file if true (Col. 8, Ln. 25 – 54).

16. As to claim 8, Herrmann teaches the method recited in Claim 4, wherein the handler routine comprises instructions for scanning the associated file and determining the application functionality that is needed to execute the associated file (Col. 9 Ln. 43 – 45).

17. As to claim 9, see the rejection of claim 2.

18. As claim 10, Herrmann teaches a Computer (Client Side 510 Col. 10, Ln. 29 – 54), a Network (Internet Connection 520 Col. 10, Ln. 29 - 54), a Set of application Functionality (Application Object Repository 543 Col. 10, Ln. 29 – 54), creating a list of file stored locally on the computer (Col. 8, Ln. 25 – 42: NOTE: Although document identification engine (DIE) is not explicitly taught, the creation of the file must have to be implemented by some type routine/engine. Therefore any routine/engine that creates

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the file is the DIE. Also, Herrmann teaches the creation of a single file, however the creation of a plurality of files would be obvious to one of ordinary skill in the art to implement since this file could be a cabinet file (Col. 9, Ln. 56 – 65), sending the list of files from the DIE to a document mapping engine (DME), causing the DME to identify a proper handler routine for each file, sending each file from the DME to the proper handler routine, causing the handler routine to identify the application functionality, sending a list of needed application functionality of the handler routine to the DME, sending a list of needed application functionality from the DME to a migration engine (ME), causing the ME to determine the current status of the needed application functionality and installing the application functionality from a remote location if it not installed locally (Col. 8, Ln. 25 – 42, Col. 9, Ln. 32 – 55: NOTE: The DME, ME and their steps, though not explicit are inherent because the purpose of the DME and ME is to find and download the appropriate application functionality and the phrase "...also includes information necessary to find and download the program code..." does just that. It finds and downloads the appropriate application functionality by using the technique for associating a host application with a document through the use of MIME types (Col. 8, Ln. 25 – 42). Also see the rejection of claim 1.

19. As to claim 10. (Previously Presented) A method for identifying a set of application functionality to be stored on a computer connected to a network, comprising the steps of: causing a document identification engine (DIE) to create a list of a plurality of files stored locally on the computer; sending the list of files from the DIE to a

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document mapping engine (DME); causing the DME to identify a proper handler routine for each file in the list of files; sending each file from the DME to the proper handler routine; causing the handler routine to identify the application functionality needed to execute each file when the computer is disconnected from the network; sending a list of needed application functionality of the handler routine to the DME; sending a list of needed application functionality from the DME to a migration engine (ME); causing the ME to determine the current status of the needed application functionality; and if the status of the needed application functionality indicates that the needed application functionality is not installed locally on the computer, then causing the ME to install the needed application functionality to the computer.

20. As to claim 11, Herrmann teaches a computer-readable medium comprising computer-readable instructions, which when executed, performs the steps of Claim 10 (Main Memory 102, Mass Storage 107).

21. As to claim 12, Herrmann teaches the method of claim 6 wherein the step of determining whether each file found in the plurality of storage locations is to be stored locally is based on a set of rules (the rules of URL and hyperlinks Col. 9, Ln. 33 – 42).

22. As to claim 13, Herrmann teaches the method of claim 6 wherein the step of determining whether each file found in the plurality of storage locations is to be stored locally is based on a user's usage patterns (Col. 12, Ln. 42 – 55).

23. As to claim 14, Herrmann teaches the method of claim 4 wherein the step of identifying application functionality needed to run each file comprises determining whether each file needs multiple application functionality (Col. 9, Ln. 56 – 65).

24. As to claim 15, Herrmann teaches the method of claim 14 wherein the step of determining whether each file needs multiple application functionality comprises mapping application functionality to a file embedded in a file in the set of files (hyperlinks Col. 9, Ln. 32 – 42).

25. As to claim 16, Herrmann does not explicitly teach the method of claim 15 wherein the embedded file is an Object Linking and Embedding (OLE) object. However, Herrmann employs OLE in the use of Globally Unique Identifier (GUID) to identify a particular application. And since the files must use GUID to associate with any application it would be safe to say that the embedded file would implement OLE (Col. 8, Ln. 11 – 24).

26. As to claim 17, Herrmann teaches the method of claim 15 wherein the embedded file is a hyperlink (Col. 9, Ln. 32 – 42).

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27. As to claim 18, Herrmann does not explicitly teach the step of causing the handler to notify the DME of an embedded file, and in response to the notification of the embedded file the DME transmits the embedded file to another handler.

Herrmann teaches a handler routine, an embedded file (Col. 9, Ln. 32 – 54) and DME as explained in claim 10. The transmission of the embedded file to another handler would be inherent because each file is associated with a handler, an embedded file implies more than one file therefore each of the files would be associated with a different handler.

28. As to claim 19, Herrmann does not explicitly teach the step of sorting the application functionality according to a frequency of occurrence.

Herrmann teaches that the application functionality could be stored locally or remotely (Col. 9, Ln. 32 – 54). One of the reasons of storing applications locally is for easy access to applications that are frequently used, thus storing locally those applications that occur frequently is sorting the applications according to frequency of occurrence.

29. As to claim 20, Herrmann does not explicitly teach the step of causing the handler to return importance ranking associated with the application functionality however, by first looking locally for the application and then remotely (Col. 9, Ln. 32 – 54) the handler has prioritized the sequence of finding the appropriate application and in so doing would return the applications according to their importance.

30. As to claims 21 - 27, see the rejection of claims 1 and 4.

31. As to claim 28, claim 10 covers claim 28. Also note that the steps of reviewing is inherent in the phrases "...packaging a document object..." and "...appropriate for hosting document..." Col. 8 Ln. 25 – 67).

Response to Arguments

32. Applicant's arguments filed 2/18/04 have been fully considered but they are not persuasive.

33. As per applicant's argument that the Peterson prior art cannot be cited in an obviousness rejection pursuant to 35 U.S.C. § 103(c). The Examiner disagrees. The 35 U.S.C. § 103(c) referred to by applicant **only** applies to applications filed on or after November 29, 1999, but applicant's application was filed on December 30, 1998. See MPEP § 706.02(k) [R-1].

34. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, firstly the prior arts of Herrmann and Peterson are analogous because both references are internet-based content delivery in a client-server system. Secondly the motivation for combining

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the prior references is to allow a user browse through the Web content while offline, in the same manner that he/she browses the content while online (Col. 12 Ln. 41- 43).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E Anya whose telephone number is (703) 305-3411. The examiner can normally be reached on M-F (8:30-6:00) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, An Meng-Ai can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cea.

Charles E Anya
Examiner
Art Unit 2126


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